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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,031	07/25/2003	Gopala Pillai	KMI010USU	3706
45180	7590	11/22/2004	EXAMINER	
GRIMES & BATTERSBY, LLP 488 MAIN AVENUE, THIRD FLOOR NORWALK, CT 06851			ABDELWAHED, ALI F	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/627,031	PILLAI ET AL.	
	Examiner Ali Abdelwahed	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 August 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 18 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11, 13-17 and 19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. 20041117.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Objections***

Claims 1, 2, 4, 6, 7, 9-11, 14-17, and 19 are objected to because of the following informalities:

It is suggested that in:

Claim 1, line 6, before "...upper portion..." delete "the" and insert –an--.

Claim 1, lines 12, 16, 18 and 19, delete "appendage" and insert –appendages--.

Claim 1, line 13, delete "surface" and insert –surfaces--.

Claim 1, line 15, delete "at least one appendage" and insert –appendages--.

Claim 1, line 17, delete "the".

Claim 2, lines 2 and 4, delete "appendage" and insert –appendages--.

Claim 4, line 4, delete "appendage is" and insert –appendages are--.

Claims 6 and 7, lines 1 and 2, respectively, delete "ribbed elements" and insert – ribs--.

Claim 9, line 2, before "...on said body..." delete "surface" and insert --surfaces--.

Claim 9, line 2, delete "is" and insert --are--.

Claim 9, line 3, delete "appendage is" and insert --appendages are--.

Claim 10, lines 1 and 3, delete "element" and insert --elements--.

Claim 10, line 2 delete "appendage is" and insert --appendages are--.

Claim 10, line 3, delete "is" and insert --are--.

Claim 10, line 4, delete "surface" and insert --surfaces--.

Claim 10, line 5, delete "ribbed elements" and insert --ribs--.

Claim 10, lines 5 and 6, delete "appendage is" and insert --appendages are--.

Claim 11, line 4, delete "said leg or wing to".

Claim 11, line 4, delete "appendage is" and insert --appendages are--.

Claim 14, lines 1 and 2, delete "at least one appendage" and insert --  
appendages--.

Claim 15, line 4, before "...upper portion..." delete "the" and insert --an--.

Claim 15, line 11, delete "the" and insert --an--.

Claim 15, lines 11, 15, 17, 19, and 20, delete "appendage" and insert --  
appendages--.

Claim 15, line 12, delete "surface" and insert --surfaces--.

Claim 15, line 14, delete "at least one appendage" and insert --appendages--.

Claim 15, lines 18 and 20, delete "the".

Claim 15, line 23, delete "appendage is" and insert --appendages are--.

Claim 16, lines 2 and 3, delete "appendage" and insert --appendages--.

Claim 16, line 4, delete "surface" and insert --surfaces--.

Claim 16, line 5, delete "ribbed elements" and insert --ribs--.

Claim 16, line 6, delete "appendage is" and insert --appendages are--.

Claim 17, line 2, after "...planar..." delete "surface" and insert --surfaces--.

Claim 17, line 2, delete "is" and insert --are--.

Claim 19, line 8, before "...upper portion..." delete "the" and insert --an--.

Claim 19, lines 15, 19, 21 and 22, delete "appendage" and insert --appendages--.

Claim 19, line 16, delete "surface" and insert --surfaces--.

Claim 19, line 18, delete "at least one appendage" and insert --appendages--.

Claim 19, line 20, delete "the".

Appropriate correction is required.

Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of the body and appendages being molded to simulate an animal in claim 14 have been previously recited in claim 1, lines 3, 13 and 14.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11, 13-17, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "the surface", and "said respective planar surfaces" in lines 5 and 16. There is insufficient antecedent basis for these limitations in the claim.

Claim(s) 2-11, 13 and 14 depend from rejected claim(s) 1 and include all of the limitations of claim(s) 1 thereby rendering these dependent claim(s) indefinite.

Claim 15 recites the limitations "the sides", "the surface", "the arms, legs, or wings", "the front", "the head", "the back", "the tail", "the head, tail, legs, or wings", and "said respective planar surfaces" in lines 3-9, 13, and 15. There is insufficient antecedent basis for these limitations in the claim.

Claim(s) 16 and 17 depend from rejected claim(s) 15 and include all of the limitations of claim(s) 15 thereby rendering these dependent claim(s) indefinite.

Claim 19 recites the limitations "the surface" and "said respective planar surfaces" in lines 7 and 19. There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 13-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,980,260 to Caputi in view of U.S. Patent No. 5,380,233 to Numoto.

Caputi discloses the claimed invention except for having an arcuate ridge, a means for limiting the rotational and linear movement of the appendage relative to the body comprised of a pair of complementary ribbed elements disposed on the planar surfaces, wherein one set of ribbed elements are comprised of beveled raised elements and the other set of ribbed elements are comprised of beveled recessed elements that engage each other when the appendage is attached to the body; the magnetic elements are disposed within the planar surfaces of the body and appendage; and wherein the ribs are approximately 0.75mm wide and 0.75mm deep and have a diameter of approximately 9.75mm.

However, Numoto teaches an attachment means for attaching appendages to a figure comprising an arcuate ridge (see fig. 5, defined by reference numeral 52), and that limit the rotational and linear movement of the appendage relative to the body, and is comprised of a pair of complementary ribbed elements (56), wherein one set of ribbed elements are comprised of beveled raised elements (57) and the other set of ribbed

elements are comprised of beveled recessed elements (53) that engage each other when the appendage is attached to the body (see figs. 5, 6); magnetic elements (60, 63) that are disposed within the planar surfaces of the body and the elements configured to be attachable to the body (see figs. 5, 6).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the toy of Caputi, in view of Numoto, such that it would provide the toy of Caputi with the concept of the aforementioned limitations for the purpose of providing a stronger and more secure attachment structure for the appendages and body of the toy.

Additionally, it would have been an obvious matter of design choice to modify the size of the ribs to be approximately 0.75mm wide and 0.75mm deep and have a diameter of approximately 9.75mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Furthermore, there is no criticality for these limitations anywhere in the specification of the present invention (see pgs. 13 and 14, lines 24-26 and 1, respectively).

Claims 1-10, 13-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,375,604 to Alonso in view of U.S. Patent No. 5,380,233 to Numoto.

Alonso discloses the claimed invention except for having an arcuate ridge, a means for limiting the rotational and linear movement of the appendage relative to the body comprised of a pair of complementary ribbed elements disposed on the planar surfaces, wherein one set of ribbed elements are comprised of beveled raised elements and the other set of ribbed elements are comprised of beveled recessed elements that engage each other when the appendage is attached to the body; the magnetic elements are disposed within the planar surfaces of the body and appendage; wherein the ribs are approximately 0.75mm wide and 0.75mm deep and have a diameter of approximately 9.75mm; and wherein the diameter of the planar surfaces of the body and appendage is approximately 21mm and 19mm, respectively.

However, Numoto teaches an attachment means for attaching appendages to a figure comprising an arcuate ridge (see fig. 5, defined by reference numeral 52), and that limit the rotational and linear movement of the appendage relative to the body, and is comprised of a pair of complementary ribbed elements (56), wherein one set of ribbed elements are comprised of beveled raised elements (57) and the other set of ribbed elements are comprised of beveled recessed elements (53) that engage each other when the appendage is attached to the body (see figs. 5, 6); magnetic elements (60, 63) that are disposed within the planar surfaces of the body and the elements configured to be attachable to the body (see figs. 5, 6).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the toy of Alonso, in view of Numoto, such that it would provide the toy of Alonso with the concept of the aforementioned limitations

for the purpose of providing a stronger and more secure attachment structure for the appendages and body of the toy.

Additionally, it would have been an obvious matter of design choice to modify the size of the ribs to be approximately 0.75mm wide and 0.75mm deep and have a diameter of approximately 9.75mm, and to modify the diameter of the planar surfaces of the body and appendage to be approximately 21mm and 19mm, respectively, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Furthermore, there is no criticality for these limitations anywhere in the specification of the present invention (see pgs. 13 and 14, lines 24-26 and 1-4, respectively).

### ***Response to Arguments***

Applicant's arguments filed on 26 August 2004 have been fully considered but they are not persuasive.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the

art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, the Numoto reference was combined with the Caputi and Alonso references to merely teach the concept of having the specific attachment means claimed in the present invention.

Concerning Applicant's argument that Numoto does not teach the specific attachment means as claimed. Examiner would like to focus Applicant's attention to the rejections made above that outline the specific limitations of the attachment means of the present invention and the corresponding elements of Numoto.

With regards to Applicant's argument that the size of the ribs is merely a matter of design choice, Examiner would like to note that specification provides no criticality for the claimed limitations regarding the specific size of the ribs. Therefore, without any criticality in the specification for the specific size of the ribs, it would be considered a matter of design choice and obvious to one of ordinary skill in the art to modify the prior art of record to meet the claimed limitations, absent any showing of unexpected results.

Examiner therefore reasserts the rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

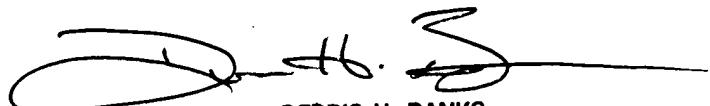
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (571) 272-4417. The examiner can normally be reached Monday through Friday from 10:00 A.M. to 6:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (571) 272-4483.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

AA  
11/17/2004



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